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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,516	10/17/2001	Steven A. Shaya	JJCC-0003	7651

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EXAMINER	
THEIN, MARIA TERESA T	

ART UNIT	PAPER NUMBER
3627	

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/981,516	SHAYA ET AL.	
	Examiner	Art Unit	
	Marissa Thein	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 August 2005 and 15 September 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-29 and 103* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-29 and 103* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *10-03-05*
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Applicants' "Reply Pursuant to 37 CFR § 1.111" filed on August 22, 2005 and "Reply Pursuant to 37 CFR § 1.121" filed on September 15, 2005 have been considered.

Applicants' response pertaining to the Election/Restrictions has been considered. Applicants' election with traverse of Group 1, claims 1-29 in the reply filed on January 28, 2005 is acknowledged.

Applicants' response to 35 USC § 101 has overcome the Examiner's rejection of such claims under 35 USC § 101.

Claim 1 is amended. New claim 103 is added. Claims 30-102 have been canceled. Claims 1-29 and 103 remain pending in this application.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on October 3, 2005 is being considered by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 103 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 103 is unclear because of the combining of two different statutory classes of invention in a single claim. In the preamble, the claim refers to a system, but the body of the claim discusses the specifics of what looks like a computer readable medium (one or more computing devices) claim which is executing a code. If Applicants decide to recite the claim as a computer readable medium (one or more devices), the claim would be rejected under 35 USC 101 because it fails to recite a computer readable medium comprising a program and having computer executable instructions. The claim seems to be directed to a computer readable medium. The claim fails to recite a positive functional interrelationship between the medium and the program and the executable instructions. Please refer to MPEP 2106. For examination purposes, the Examiner will interpret the claim to recite a system.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8, 18-22, 28-29, and 103 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,782,307 to Wilmott et al.

Regarding claims 1 and 103, Wilmott discloses a method and system for formulating individualized product recommendation comprising: receiving a first set of

data from a consumer regarding a target substrate (col. 3, lines 34-42; col. 3, line 66-col. 4, line 12; Figure 2); and generating a set of individualized product recommendation for the consumer from a plurality of products within a product category with the assistance of one or more computing devices, the generating comprising feeding the first set of data as inputs into an intelligent performance-based product recommendation engine, operating on the inputs with a data processing portion of the product recommendation engines, and producing a set of outputs from the data processing portion of the product recommendation engine, the outputs comprising the set of individualized product recommendation (col. 3, lines 56-65; col. 2, lines 52-65; col. 7, lines 20-50; Figure 2).

Regarding claims 2-8, Wilmott discloses receiving a concern about the substrate; severity of the concern; and importance of the concern (Figure X2; Figures X3-A - X3-C; col. 6, lines 22-31); receiving a second set of data from the consumer, the second set of data comprising historical data and wherein the first and second set of data comprise the inputs into the product recommendation engine (Figure X3-A; col. 3, lines 58-62); a third set of data from the consumer comprising personal profile information about the consumer (col. 3, lines 35-42).

Regarding claims 18-21, Wilmott discloses generating ancillary information output from the product recommendation engine inputs regarding effects of at least of the products and the condition of the target substrate relative to a designated population of consumers (col. 5, lines 23-43).

Regarding claims 22 and 28-29, Wilmott disclose a web page (col. 2, lines 56-58); and receiving a first set of data about the consumer's skin and the generation a set of individualized product recommendation for the consumer step comprises generating a set of individualized product recommendation from a plurality of skin-care products (Figures X3A - X3C; Figure X2); and payment (col. 9, line 46; col. 9, line 60).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,782,307 to Wilmott et al. Wilmott substantially discloses the claimed invention, however, it does not disclose the particular data processing portion (a neural network portion, a collaborative filter portion, a content-based portion, and cascaded content-based filter). Although the reference is silent to the particular portion, it would have been obvious to one of ordinary skill in the art to have provided the portion already disclosed by Wilmott to have been a neural network portion, a collaborative filter portion, a content-based portion, and cascaded content-based filter, such portions would have been recognized by the skilled artisan as being one of numerous portions suitable in the operation. Moreover, applicant has not persuasively demonstrated that the particular data processing portion is critical or is anything more than one of the

numerous data processing portions that the skilled artisan would have found suitable for the purpose taught by Wilmott.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use a neural network portion, a collaborative filter portion, a content-based portion, and cascaded content-based filter inputs to provide the operation, such as the data processing portion taught in Wilmott, for the purpose of providing a recommendation.

Claims 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No 6,782,307 to Wilmott et al in view of U.S. Patent No. 6,321,221 to Bieganski.

Regarding claims 13-17, Wilmott substantially disclose the claimed invention, however, it does not disclose producing a first of products and a scored predicted and performance utility; producing a first list of top-N products and a scored predicted and performance; and a first list of products and a purchase price. Wilmott does disclose a method where the user is asked to select the general type of product they are interested in (col. 3, lines 56-57). The indication is modified in accordance with the user profile, and perhaps history of prior orders to emphasize products which may be of particular interest and remove the times which hare unlikely to interest the customer or feature them less prominently (col. 3, lines 61-63).

Bieganski, on the other hand, teaches producing a first of products and a scored predicted and performance utility; producing a first list of top-N products and a scored

predicted and performance; and a first list of products and a purchase price (col. 3, lines 26-56; col. 5, lines 32-43; col. 9, lines 10-18).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Wilmott, to include the first list, score and price, as taught by Bieganski, in order to generate the highest-ranking preference values (Bieganski, col. 2, lines 64-65).

Regarding claims 23-27, Wilmott substantially discloses the claimed invention, however, it does not disclose the receiving feedback from the consumer regarding use of a product to treat the target substrate; feedback from the consumer regarding use of previously recommended product; receiving preference data regarding the product; performance data; and retraining the product recommending engine based on the feedback. Wilmott does disclose a method where the user is asked to select the general type of product they are interested in (col. 3, lines 56-57). The indication is modified in accordance with the user profile, and perhaps history of prior orders to emphasize products which may be of particular interest and remove the times which hare unlikely to interest the customer or feature them less prominently (col. 3, lines 61-63).

Bieganski, on the other hand, teaches the receiving feedback as recited in the claims (col. 11, lines 48- col. 12, line 10). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Wilmott, to include the receiving feedback, as taught by Bieganski, in order to recommend items with high confidence level (Bieganski, col. 3, lines 18-19).

Response to Arguments

Applicant's arguments filed August 22, 2005 and September 15, 2005 have been fully considered but they are not persuasive.

Applicants remark that "Wilmott's 102(e) data is after the priority date of this application". Specifically, Applicants remark that "the international application that Wilmott is based upon failed to contain '*a specific reference to*' any of the three provisional applications". Applicants further remark that "Wilmott cannot be, and is not, prior art to Applicants' claims under the current version of § 102(e)".

First, a review of the cover sheet of the international application publication (WO 01/58238) of the international application (PCT/US0103168) reveals a specific reference to United States Provisional Applications 60/179,057; 60/191,878; 60/216,847. Accordingly, Applicants' remark that Wilmott fails to contain a specific reference to any of the three provision applications is not persuasive.

Second, MPEP § 2136 states as follows:

> "The revised statutory provisions supercede all previous versions of 35 U.S.C. 102(e) and 374, with only one exception, which is when the potential reference is based on an international application filed prior to November 29, 2000. The provisions amending 35 U.S.C. 102(e) and 374 in Pub. L. 107-273 are completely retroactive to the effective date of the relevant provisions in the AIPA (November 29, 2000). Revised 35 U.S.C. 102(e) allows the use of certain international application publications and U.S. patent application publications, and certain U.S. patents as prior art under 35 U.S.C. 102(e) as of their respective U.S. filing dates, including certain international filing dates. The prior art date of a reference under 35 U.S.C. 102(e) may be the international filing date if the international filing date was on or after November 29, 2000, the international application designated the United States, and the international application was published by the World Intellectual Property Organization (WIPO) under the Patent Cooperation Treaty (PCT) Article 21(2) in the English language."

In the instant case, Wilmott is a continuation of international application PCT/US01/03168, filed January 31, 2001. Such international application was filed after November 29, 2000, and, accordingly, is not subject to the exception noted above in MPEP § 2136. A further review of the international application publication upon which the international application is based reveals a designation of the United States, and that it is published in English. As a result, the effective date of the Wilmott reference is that of the provisional applications. Applicants' attention is directed to MPEP § 706.02(f)(1) and Flowcharts for 35 USC 102(e) Dates (chart 1) for examination guidelines on the application of 35 U.S.C. 102(e). Accordingly, Applicants' remarks that Wilmott is not prior art under the current version of 102(e) are not persuasive.

Applicants remark that "Wilmott does not teach or disclose "generating a set of individualized product recommendation for the consumer from a plurality of products with a product category by operating on the inputs [received from a consumer] with a data processing portion of the [intelligent performance-based] product recommendation engine".

The Examiner notes that Wilmott does teach and disclose "generating a set of individualized product recommendation for the consumer from a plurality of products with a product category by operating on the inputs [received from a consumer] with a data processing portion of the [intelligent performance-based] product recommendation engine". Wilmott discloses a system, which includes a user questionnaire module that administers the user questionnaire and stores and access user profiles in the database (col. 7, lines 24-26; Figure 2). A custom product selection module provides users of the

system with appropriate customization forms for the product of interest with reference to customization information stored in a formulation database (col. 7, lines 26-30). The customer product selection information is fed into a formulation generator which, with reference to appropriate information in the formulation database, selects the predefined formulation, modifies it in accordance with the user's product selection and perhaps with the user profile stored in the database and/or various external factors which are programmed into the system or provided via an external data port (col. 7, lines 30-38). The formulation generator can be configured to output the formulation product (col. 7, lines 39-40).

Such a user questionnaire module that administers the questionnaire; a custom product selection module which provides users of the system with appropriate customization forms for the product of interest; and the customer product selection information is fed into a formulation generator which selects the predefined formulation and modifies in accordance with the user's product selection and/or various external factors which are programmed into the system or provided via and external data port are considered "generating a set of individualized product recommendation for the consumer from a plurality of products with a product category by operating on the inputs [received from a consumer] with a data processing portion of the [intelligent performance-based] product recommendation engine".

Applicants remark that "Wilmott also does not generate is customized formulation based on the past performance of that formulation by previous persons who had suitably similar concerns they wanted addressed".

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., Wilmott does not generate is customized formulation based on the past performance of that formulation by previous persons who had suitably similar concerns they wanted addressed) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicants remark that "Wilmott's system and methods of generating a customized cosmetic or pharmaceutical formulation do not even classify a user *vis-a-vis* a relevant population of prior persons who used the customized formulation or a suitable similar customized formulation as the one generated for the particular user".

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., Wilmott's system and methods of generating a customized cosmetic or pharmaceutical formulation do not even classify a user *vis-a-vis* a relevant population of prior persons who used the customized formulation or a suitable similar customized formulation as the one generated for the particular user) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicants remark that "Wilmott makes no mention whatever of considering how past formulation generated by its system performed in the past when generating is

current formulations; and Wilmott makes no mention whatever of considering how the current user of its systems and methods compares to a population of person who used the presently recommended formulation in the process of generating the presently recommended formula".

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., Wilmott makes no mention whatever of considering how past formulation generated by its system performed in the past when generating is current formulations; and Wilmott makes no mention whatever of considering how the current user of its systems and methods compares to a population of person who used the presently recommended formulation in the process of generating the presently recommended formula) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

PCT Publication No. WO 01/058238 to Aust et al. discloses a method and system for producing customized cosmetic and pharmaceutical formations on demand.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 571-272-6764. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alex Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mtot
November 22, 2005

STEVE B. MCALLISTER
PRIMARY EXAMINER